

REMARKS

Claims 1-11 and 13-21 remain pending in the present application. Claims 1, 7 and 8 have been amended. Basis for the amendments can be found throughout the specification, claims and drawings as originally filed.

SPECIFICATION

The amendment filed 1/27/05 is objected to under 35 U.S.C. § 132(a) because it introduces new matter into the disclosure. Applicants respectfully traverse this rejection. Applicants believe the revised formula provided in the January 27, 2005 amendment is indeed inherent in the design of the application. In response to the Examiner's objection to the revision of this formula, Applicants have deleted the reference to a particular formula defining the amount of flow through spool valve 64. Withdrawal of the objection is respectfully requested.

CLAIM OBJECTIONS

Claims 1-11 and 13-21 are objected to because of informalities. The claims have been amended to overcome the objections. Withdrawal of the objection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 112

Claims 8 and 11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Applicant regards as the invention. Claim 8 has been amended to overcome the rejection. Reconsideration of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-11 and 13-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Groves, et al. (U.S. Pat. No. 6,464,048) in view of Nezu, et al. (U.S. Pat. No. 5,586,627). Applicants respectfully traverse this rejection.

The Examiner's position is that Groves, et al. includes most of the limitations of the present invention but Groves, et al. fails to include the limitation of the piston defining compression fluid passages and rebound fluid passages, the limitation of a compression valve and a rebound valve attached to the piston, and the limitation that the rebound valve opens at a higher pressure than the compression valve. The Examiner then looks to Nezu, et al. to disclose a piston having compression and rebound fluid passages, compression and rebound valves where lines 41-44 of column 40 teach that shock absorbers can be arranged such that different damping forces can be set at the extension side and the contraction side. The Examiner then states that it would be obvious to modify Groves, et al. in view of the teachings of Nezu, et al. in order to provide a means of obtaining specific damping force properties.

Column 4, line 64 to column 5, line 4 of Groves, et al. states that during the operation of shock absorber 10, there is no damping force characteristic that is determined by piston 12. The damping characteristic is controlled by servo valve assembly 22. Thus, modifying Groves, et al. with the teachings of Nezu, et al. would

change the principle of operation of Groves, et al. since it would not use the piston to determine its damping characteristics.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As stated above, using the piston of Groves to determine the damping character charges the principle of operation of Groves, et al. and thus the pending claims are not obvious over the combination.

When applying 35 U.S.C. § 103, the following two tenets of patent law must be adhered to:

- a) The claimed invention must be considered as a whole; and,
- b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination.

A prior art reference must be considered in its entirety i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983) cert. denied, 469 US 851 (1984). Here, Groves, et al. specifically teaches away from the use of the piston in creating damping loads. Thus, there is no suggestion to combine Groves, et al. with Nezu, et al. as proposed by the Examiner.


Thus, Applicants believe Claims 1-11 and 13-21 patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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